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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 09/913,378
Applicant : Baumoeller et al.
Filed : 11/02/2001
TC/A.U. : 1731
Examiner : Peter Chin

Confirmation Number: 9714

Docket No. : H 3954 PCT/US
Customer No.: 23657

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 13, 2004.

May 13, 2004
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 222313-1450


Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192.

Please charge the required fee of \$330.00 to our Deposit Account No. 50-1177. This paper is enclosed in triplicate. Order No. 04-0234.

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Respectfully submitted,



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Ambler, PA 19002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Baumoeller et al. Confirmation No.: 9714
Appl. No. : 09/913,378
Filed : 11/02/2001
Title : USE OF EMULSIONS AS IMPREGNATING AGENTS AND
REVIVING AGENTS

Grp./A.U. : 1731
Examiner : Peter Chin

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BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Deutschland GmbH & Co. KG,
Henkelstrasse 67, 40589 Duesseldorf, Germany.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 10-23 are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments were made after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a process for making paper substrates having a soft feel, the process involving providing a paper substrate and an emulsion containing (i) a polyol poly-12-hydroxystearate, (ii) a wax ester and (iii) a wax, and impregnating the paper substrate with the emulsion. See page 3, lines 1-19.

ISSUES

Whether claims 10-23 are anticipated under 35 U.S.C. § 102(e) by de Haut et al. (US 6,207,014) or, in the alternative, rendered obvious under 35 U.S.C. § 103(a).

GROUPING OF THE CLAIMS

The claims do not stand and fall together since the limitation disclosed in claim 16 is neither anticipated nor rendered obvious by the prior art of record.

ARGUMENT

de Haut '014 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Appellant would first like to note that it is well settled in the law that a factual

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determination of anticipation requires the disclosure, in a single reference, of each and every element of a claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). Appellant respectfully submits that the '014 reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

More particularly, the '014 reference fails to disclose a combination of the claimed polyol poly-12-hydroxystearate, the claimed wax component, and the claimed amount of wax ester in an emulsion composition for use on paper substrates. On the contrary, the '014 reference clearly discloses that neither the polyol poly-12-hydroxystearate nor the wax component are required in its lotion, see col. 5, lines 66-67 of the '014 reference. Furthermore, the '014 reference also clearly teaches that its emulsifier may be ionic in nature rather than nonionic, see. col. 7, lines 39-41. As a result, since this reference fails to disclose an emulsion composition containing each and every element of the claimed invention, it clearly cannot serve to anticipate the claimed invention.

As for the Examiner's obviousness rejection under 35 U.S.C. § 103(a), Appellant respectfully submits that the '014 reference fails to contain the requisite teaching or suggestion to **motivate** one skilled in the art to wish to employ: (1) the claimed polyol poly-12-hydroxystearate; (2) the claimed wax component; and (3) the claimed amount of wax ester in its emulsion composition. With regards to the claimed polyol poly-12-hydroxystearate, the '014 reference clearly teaches the use of an emulsifier, in general, as being **merely optional**. However, in the event that a routineer would choose to employ an emulsifier, this reference teaches **two types of surfactants** from which to choose, i.e., nonionic surfactants and/or amphoteric surfactants. Now, in the event that the routineer would, for some reason not evident from the disclosure of the '014 reference, choose to first, employ an emulsifier and second, employ a nonionic surfactant as the emulsifier,

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rather than an ionic surfactant, this reference then teaches **5 classes** of nonionic surfactants, each class having numerous candidates from which to choose, one of which being the claimed polyol poly-12-hydroxystearate. Clearly, numerous critical decisions would need to be made in order for the routineer to arrive at the claimed polyol poly-12-hydroxystearate for use in the '014 formulation, none of which appear to be motivated based on the teachings of the reference.

This being the case, Appellant would like to note that it is well settled that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, Ex parte Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). In Ex parte Wittpenn, 16 USPQ2d 1730 (BPAI 1990), the Examiner had rejected an Applicant's claims on the grounds that all of the claimed components were disclosed in a prior art reference (Roggenkamp). In that case it was found that although the prior art contained all elements of the Applicant's invention, the prior art indicated **no preference** for any particular component of one of the elements, i.e., the nonionic surfactant. The Board there held that, "... since we have been apprised of no disclosure within the Roggenkamp reference that would have led the routineer to make the **critical** selections to arrive at the claimed surfactant composition, we find that no prima facie case of obviousness has been established and that the rejection before us cannot be sustained." *Id.* at 1731 (emphasis added). Here too, there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) choose to employ an emulsifier, particularly since its use is clearly disclosed as being merely optional and would add cost to the finished formulation; (2) choose to employ a nonionic surfactant, rather than an amphoteric surfactant; (3) choose to employ a polyol, rather than any other type of nonionic surfactant; (4) choose to employ a polyol poly-12-hydroxystearate, rather than any of the other numerous polyol candidates; and (5) choose to employ the polyol poly-12-hydroxystearate in the claimed amount. Consequently, this element of the claimed invention is not believed to be rendered obvious by the teaching or suggestion of the '014 reference.

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Moreover, with respect to the use of the claimed polyol poly-12-hydroxystearate in combination with both the waxy ester and wax components, it is clearly seen by way of Appellant's examples that the presence of all three components is necessary in order to achieve exceptional softness and skin feel. As a result, the unexpected results associated with the claimed invention are clearly NOT motivated anywhere within the teachings of the '014 reference.

With regards to the wax component, its use is also taught as being merely optional. If one chooses to substitute some of the water in the '014 formulation for an obviously more costly ingredient, then they need to then choose to decide to use either a wax component or an oil component. Here too, there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) use a wax component which is clearly disclosed as being merely optional and which will add to the cost of the finished formulation; and (2) use wax rather than oil.

For all of the above-disclosed reasons, Appellant respectfully submits that the '014 reference fails to render the claimed invention prima facie obvious.

SUMMARY

de Haut '014 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

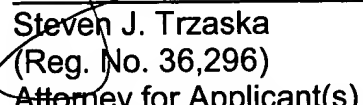
de Haut fails to render the claimed invention prima facie obvious on the grounds that it fail to contain the requisite teaching or suggestion which would motivate one of ordinary skill in the art to make all of the critical selections necessary to arrive at the emulsion composition employed in the process of the present invention.

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It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,

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Enc.: Appendix

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APPENDIX

CLAIMS ON APPEAL

10. A process for making paper substrates having a soft feel comprising:
- (a) providing a paper substrate;
 - (b) providing an emulsion containing:
 - (i) a polyol poly-12-hydroxystearate;
 - (ii) a wax ester; and
 - (iii) a wax; and
 - (c) impregnating the paper substrate with the emulsion.
11. The process of claim 10 wherein the polyol poly-12-hydroxystearate is polyglycerol poly-12-hydroxystearate.
12. The process of claim 10 wherein the polyol poly-12-hydroxystearate is present in the emulsion in an amount of from about 5 to 25% by weight, based on the weight of the emulsion.
13. The process of claim 12 wherein the wax ester corresponds to formula (I):
- $$R^1COO-R^2 \quad (I)$$
- wherein R^1CO is a linear or branched acyl group having from 6 to 22 carbon atoms and up to 3 double bonds, and R^2 is a linear or branched alkyl and/or alkenyl group having from 6 to 22 carbon atoms, and wherein the total number of carbon atoms present in the ester is at least 20.
14. The process of claim 10 wherein the wax ester is present in the emulsion in an amount of from about 50 to 90% by weight, based on the weight of the emulsion.
15. The process of claim 10 wherein the wax is present in the composition in an amount of from about 5 to 25% by weight, based on the weight of the emulsion.
16. The process of claim 10 wherein the paper substrate is based on up to about

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95% by weight recycled paper pulp.

17. The product of the process of claim 10.
18. The product of the process of claim 11.
19. The product of the process of claim 12.
20. The product of the process of claim 13.
21. The product of the process of claim 14.
22. The product of the process of claim 15.
23. The product of the process of claim 16.